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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/582,256	03/05/2007	Robert P. Flath	Y2428-00065	1267

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DUANE MORRIS LLP
PATENT DEPARTMENT
1540 BROADWAY
NEW YORK, NY 10036-4086

EXAMINER	
PURDY, KYLE A	

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1611	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/582,256	FLATH ET AL.	
	Examiner	Art Unit	
	Kyle Purdy	1611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06/09/2006 and 02/05/2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-65* is/are pending in the application.

4a) Of the above claim(s) *12-65* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *4 pages (09/28/2007)*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election Acknowledged/ Status of Application

1. Applicant's election of Group I encompassing claims 1-11 in the reply filed on 02/05/2008 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Restriction is deemed proper and is made final.

2. Claims 1-65 are pending and claims 1-11 are presented for examination on the merits. The following rejections are made.

Applicants Invention

3. Applicants are claiming a co-extruded dosage form comprising a core and a shell, the core comprising an adverse agent and a hydrophobic material and the shell comprising an active agent as well as a hydrophobic material. The dosage may be in the form of a tablet of caplet. The dosage form may also be in the form of a capsule wherein the capsule comprises a plurality of particles having a particle size of about 0.1-3.0 mm (see interpretation of claim 8 under 112, 2nd).

Claim Objections

4. Claim 8 is objected to because of the following informalities: 'form' is misspelled. It is currently spelled 'from'. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. **Claims 8-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

7. Claim 8 is directed to the co-extruded dosage form which ultimately depends from claim 1. Claim 1 is directed to a co-extruded dosage form comprising a core and a shell, the core comprising an adverse agent and the shell comprising an active agent, wherein the shell at least partially surrounds the core. Claim 8 is directed to the co-extruded dosage form being in the form a capsule containing a plurality of particles. It is unclear what a plurality of particles is referring to. Does the plurality of particles refer to the adverse agent in the core? Does the plurality of particle refer to the co-extruded dosage form being filed into a capsule? Nowhere in Applicants specification is there mention of the co-extruded dosage form directly forming a capsule comprising a plurality of particles. However, there is mention of a capsule dosage form comprising therein a plurality of the co-extruded particles (see [0047] and [0112]). Clarification is politely requested.

8. In light of this, claim 8 is being interpreted as a capsule wherein the capsule comprises a plurality of particles being the co-extruded dosage form of claim 1.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. **Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Kao et al. (US 2003/0004177).**

11. Kao et al. ('Kao herein) is drawn to an abuse-resistant opioid dosage form which comprises an opioid agonist and an opioid antagonist, wherein the opioid antagonist is contained in a separate matrix from the opioid agonist (see Example 1). Applicant is directed to Example 1 wherein a method for making a tablet possessing such properties is disclosed. The tablet contains a granule and a coating layer (see instant claim 1). The granule (or core) contains naloxone HCl (an adverse agent; an opioid antagonist) (see instant claims 1 and 5). The core also contains Eudragit RS30D (a hydrophobic material) (see instant claim 2). The core is the coated with a layer (i.e. a shell) containing oxycodone (an opioid agonist; an active agent) (see instant claims 1 and 5). The coating layer also comprises Eudragit (a hydrophobic material) (see instant claims 4). The granules are then compressed into a tablet (see instant claims 6 and 7).

12. It appears that Applicants product is a product-by-process wherein the dosage is formed by a co-extrusion process. However, product-by-process claims are not limited to the manipulations of the recited steps, but only the structure implied by the steps. The patentability of a product does not depend on its method of production. See MPEP 2113. Thus, as Applicants

dosage form is identical to that of the reference, the limitations of the instant claims are anticipated by Kao.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

14. **Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kao et al (US 2003/0004177) in view of Gandhi et al. (PSTT, 1999, 2(4), 160-170).**

15. Kao et al. ('Kao herein) is drawn to a abuse-resistant opioid dosage form which comprises an opioid agonist and an opioid antagonist, wherein the opioid antagonist is contained in a separate matrix from the opioid agonist (see Example 1). The major motivation for combining a opioid receptor antagonist with an agonist is to prevent or deter opiate addicts from abusing the medicament. If the medicament were crushed and injected into the body, a large bolus of antagonist would be released, bind to the opioid receptors interfering with the action of the agonist and potentially causing symptoms of withdrawal thereby deterring future abuse (see [0024]). When the tablet is properly taken orally, because of the antagonists low bio-availability, the antagonist has little effect when the tablet is taken as intended (see [0004]).

16. Applicant is directed to Example 1 wherein a method for making a tablet comprising a core possessing an adverse agent and a shell comprising an active agent is disclosed. The tablet contains a granule and a coating layer (see instant claim 1). The granule (or core) contains

naloxone HCl (an adverse agent; an opioid antagonist) (see instant claims 1, 5 and 10). The core also contains Eudragit RS30D (a hydrophobic material) (see instant claim 2). The core is the coated with a layer (i.e. a shell) containing oxycodone HCl (an opioid agonist; an active agent) (see instant claims 1, 5 and 10). The coating layer also comprises Eudragit (a hydrophobic material) (see instant claims 4). The granules are then compressed into a tablet (see instant claims 6 and 7). The method used to make the pellets (collective granule with coating shell) is that of a fluidized bed process which is commonly used in the forming of pellets used in capsule preparation. It is noteworthy that the teaching of Kao suggests that that oral composition can be applied equally to capsules (see [0009]).

17. Kao fails to teach the dosage form as being in the form of a capsule containing a plurality of particles, the particles ranging in size from about 0.1 to about 3.0 mm in all dimensions.

18. The teaching of Gandhi is a review article drawn to extrustion and spheronization in the development of oral-controlled release dosage forms. It is taught that fluidized bed technology produces pellets that can be used to fill two-piece hard gelatin capsules (see page 161, right column, 5th paragraph and page 166, left column, 2nd paragraph). The pellets produced by such process result in particles having sizes ranging from 0.5 to 1.5 mm, and some applications may result in a particle having a size as large as 3.0 mm (see page 161, left column, 2nd paragraph; see instant claim 9).

19. Thus, it would have been obvious to one ordinarily skilled in the art at the time the invention was made, to combine and modify the teachings of Kao with Gandhi with a reasonable expectation for success in arriving at a dosage form comprising a core comprising an adverse agent and a shell comprising an active agent wherein the dosage form is a capsule containing a

plurality of particles ranging in size from about 0.1 mm to about 3.0 mm wherein the dosage provides controlled release of the opioid agonist following administration. The significance of Kao is that it teaches a method of making pellets possessing a core and a coating. The core material contains an adverse agent as well as a hydrophobic material and the shell coating contains an active agent and a hydrophobic material. The process for making the pellets is that of bed fluidization, a process for making controlled-release pellets that can be filled into capsules. Moreover, Kao contemplates employing capsules for the delivery of the agonist/antagonist mixtures. Still however, Kao fails to teach the particle size resulting from the process of making the pellets. Gandhi teaches that pellets made by processes such as fluidized bed processing results in particles with sizes ranging from 0.5 to 3.0 mm. It also taught by Gandhi that such pellets can be loaded into hard gelatin capsules for delivery of the medicament. One ordinarily skilled in the art would recognize that using the product produced by the steps of [0028]-[0033] of Kao would result in pellets that could be effectively loaded into a gelatin capsule with the desired continuous release properties. Therefore, the claims would have obvious to a person of ordinary skill in the art because such a person has a good reason to pursue the known options within his or her grasp, especially when the reference contemplates such options (i.e. capsule delivery). If such an undertaking leads to the inventions success, it would likely not be the product of skill but rather one of common sense and ordinary skill. Therefore, the invention as a whole is *prima facie* obvious to one ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in absence of evidence to the contrary.

20. It is noted that the instantly claimed product is a product-by-process wherein the product is formed by a co-extrusion process. However, product-by-process claims are not limited to the manipulations of the recited steps, but only the structure implied by the steps. The patentability of a product does not depend on its method of production.

Conclusion

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle A. Purdy whose telephone number is 571-270-3504. The examiner can normally be reached from 9AM to 5PM.

22. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

23. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Kyle Purdy/
Examiner, Art Unit 1611
March 17, 2008

/Michael P Woodward/
Supervisory Patent Examiner, Art Unit 1615